

ESTTA Tracking number: **ESTTA341277**

Filing date: **04/07/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

|                                       |  |
|---------------------------------------|--|
| Name                                  | Banana Republic (Apparel) LLC  |
| Granted to Date of previous extension | 04/07/2010   |
| Address                               | 2 Folsom Street<br>San Francisco, CA 94105<br>UNITED STATES  |
| Attorney information                  | James D Weinberger<br>Fross Zelnick Lehrman & Zissu, P.C.<br>866 United Nations Plaza 6th Floor<br>New York, NY 10017<br>UNITED STATES<br>jweinberger@frosszelnick.com, gwoo@frosszelnick.com Phone:(212) 813-5900 |

### Applicant Information

|                        |   |                        |            |
|------------------------|---|------------------------|------------|
| Application No         | 77783198  | Publication date       | 12/08/2009 |
| Opposition Filing Date | 04/07/2010  | Opposition Period Ends | 04/07/2010 |
| Applicant              | Andari Fashion Inc.<br>9626 Telstar Ave.<br>El Monte, CA 91731<br>UNITED STATES |                        |            |

### Goods/Services Affected by Opposition

|   |
|---|
| Class 025.<br>All goods and services in the class are opposed, namely: Coats; Dresses; Gloves; Hats; Hosiery; Jackets; Jeans; Nightgowns; Nightwear; Pajamas; Pants; Scarves; Shirts; Shorts; Skirts; Socks; Sweaters; Swim wear; Tops; Underwear |
|---|


### Grounds for Opposition

|                                      |                            |
|--------------------------------------|----------------------------|
| Priority and likelihood of confusion | Trademark Act section 2(d) |
|--------------------------------------|----------------------------|


### Marks Cited by Opposer as Basis for Opposition

|                       |            |                       |            |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 3248232    | Application Date      | 11/18/2004 |
| Registration Date     | 05/29/2007 | Foreign Priority Date | NONE       |
| Word Mark             | BR         |                       |            |

|                     |  |
|---------------------|--|
| Design Mark         |    |
| Description of Mark | NONE   |
| Goods/Services      | Class 025. First use: First Use: 2005/08/18 First Use In Commerce: 2005/08/18 Clothing, namely, t-shirts, shirts, blouses, sweaters, vests, pants, jeans, shorts, dresses, skirts, jackets, blazers, suits, coats, sleepwear, swimwear, loungewear, jogging suits, sweatshirts, socks, underwear, lingerie, athletic pants, tops, belts, scarves, ties, gloves; footwear; headwear |

|                       |   |                       |            |
|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 3524256   | Application Date      | 05/23/2006 |
| Registration Date     | 10/28/2008  | Foreign Priority Date | NONE       |
| Word Mark             | BR  |                       |            |
| Design Mark           |   |                       |            |
| Description of Mark   | NONE  |                       |            |
| Goods/Services        | Class 018. First use: First Use: 1986/06/30 First Use In Commerce: 1986/06/30 Leather, cloth and vinyl goods, namely, purses and handbags, wallets, briefcase-type portfolios, and briefcases |                       |            |

|                       |            |                       |            |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 3096787    | Application Date      | 11/18/2004 |
| Registration Date     | 05/23/2006 | Foreign Priority Date | NONE       |
| Word Mark             | BR         |                       |            |

|                     |   |
|---------------------|---|
| Design Mark         |   |
| Description of Mark | NONE  |
| Goods/Services      | Class 018. First use: First Use: 2005/12/26 First Use In Commerce: 2005/12/26 Handbags, wallets, purses, tote bags, duffel bags, briefcases, cosmetic bags sold empty, shaving bags sold empty, credit card cases, leather key cases; luggage |

|             |   |
|-------------|---|
| Attachments | 78519571#TMSN.jpeg ( 1 page )( bytes )<br>78890744#TMSN.jpeg ( 1 page )( bytes )<br>78519550#TMSN.jpeg ( 1 page )( bytes )<br>Notice of Opposition (F0607317).PDF ( 15 pages )(115447 bytes ) |
|-------------|---|

### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

|           |                         |
|-----------|-------------------------|
| Signature | /s/ James D. Weinberger |
| Name      | James D Weinberger      |
| Date      | 04/07/2010              |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 77/783,198  
Published in the *Official Gazette* on December 8, 2009  
Mark: BB BOOMER ESSENTIALS (and Design)

BANANA REPUBLIC (APPAREL), LLC,

Opposer,

-against-

ANDARI FASHION INC.,

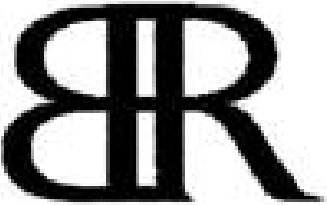
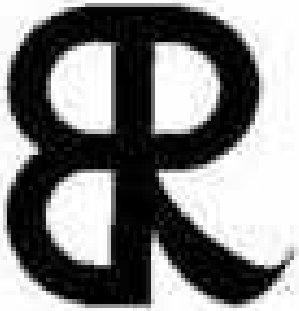
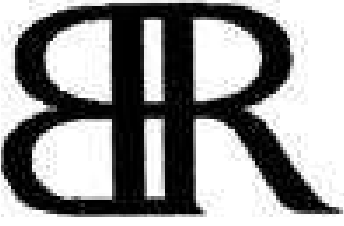
Applicant.

**NOTICE OF OPPOSITION**

Opposer Banana Republic (Apparel), LLC, a California corporation with a place of business at 2 Folsom Street, 13th Floor, San Francisco, California 94105 (“Opposer”), believes that it will be damaged by the issuance of a registration for the trademark BB BOOMER ESSENTIALS (and Design) applied for in Application Serial No. 77/783,198, filed on July 16, 2009, for “Coats; Dresses; Gloves; Hats; Hosiery; Jackets; Jeans; Nightgowns; Nightwear; Pajamas; Pants; Scarves; Shirts; Shorts; Skirts; Socks; Sweaters; Swim wear; Tops; Underwear” in International Class 25 by Andari Fashion Inc. (“Applicant”), and therefore opposes the same. As grounds for the opposition, Opposer alleges as follows:

1. Opposer is a leading in-store and online retailer of, among other things, clothing, accessories, personal care products and household goods.
2. Opposer is the owner of all right, title, and interest in and to the mark BR (and Design) in connection with retail clothing goods and services based on first use since 1988.

3. Additionally, Opposer owns numerous U.S. trademark registrations for the BR mark in connection with such goods and services, including but not limited to the following:

| <u>Mark</u>   | <u>Reg. No.</u> | <u>Reg. Date</u> | <u>Goods/Services</u>   | <u>First Use Date</u> |
|---|-----------------|------------------|---|-----------------------|
|    | 3,248,232       | May 29, 2007     | Clothing, namely, t-shirts, shirts, blouses, sweaters, vests, pants, jeans, shorts, dresses, skirts, jackets, blazers, suits, coats, sleepwear, swimwear, loungewear, jogging suits, sweatshirts, socks, underwear, lingerie, athletic pants, tops, belts, scarves, ties, gloves; footwear; headwear in Int. Cl. 25 | August 18, 2005       |
|  | 3,524,256       | October 28, 2008 | Leather, cloth and vinyl goods, namely, purses and handbags, wallets, briefcase-type portfolios, and briefcases in Int. Cl. 18  | June 30, 1988         |
|  | 3,096,787       | May 23, 2006     | Handbags, wallets, purses, tote bags, duffel bags, briefcases, cosmetic bags sold empty, shaving bags sold empty, credit card cases, leather key cases; luggage in Int. Cl. 18  | December 26, 2005     |

(Opposer's BR mark and the registrations relied upon here are collectively referred to "Opposer's Mark".) These registrations are valid, subsisting and in full effect and serve as prima facie evidence of the validity of the mark and of Opposer's exclusive right to use Opposer's

Mark in connection with the goods and services identified therein, pursuant to Section 33(b) of the Lanham Act, 15 U.S.C. § 1115(a). Attached hereto as Exhibit A are printouts from the TARR electronic database records of the U.S. Patent and Trademark Office showing the current status and title of the registrations relied upon herein.

4. Upon information and belief, Applicant is a California corporation located and doing business at 9626 Telstar Ave., El Monte, CA 917311.

5. On July 16, 2009, Applicant filed Application Serial No. 77/783,198 to register the following mark:



for “Coats; Dresses; Gloves; Hats; Hosiery; Jackets; Jeans; Nightgowns; Nightwear; Pajamas; Pants; Scarves; Shirts; Shorts; Skirts; Socks; Sweaters; Swim wear; Tops; Underwear” in International Class 25 based on a bona fide intent to use under Section 1(b) of the Lanham Act, 15 U.S.C. § 1051(b) (“Applicant’s Mark”).

6. Upon information and belief, Applicant has not commenced use of Applicant’s Mark on any goods or services in International Class 25 in the United States.

7. Upon information and belief, prior to any date on which Applicant can rely, Applicant was on actual notice of Opposer’s prior rights in and to Opposer’s Mark.

8. The filing date of Applicant’s application, July 16, 2009, which is the earliest date on which Applicant can rely upon, is decades after the use, registration and acquisition of rights in Opposer’s Mark by Opposer or its predecessors in interest. As such, Opposer’s rights in its

Opposer's Mark are prior and superior to any rights Applicant may claim in Applicant's Mark. The registration of Applicant's Mark is inconsistent with Opposer's prior rights and statutory grant of exclusivity of use.

9. Applicant's Mark is confusingly similar to the prior used and registered Opposer's Mark. The marks of the parties present nearly identical general commercial impressions and are very similar in appearance. Moreover, Applicant seeks to use its Mark in connection with clothing in International Class 25, goods that are identical to those on which Opposer has long used Opposer's Mark, as well as additional, related goods.

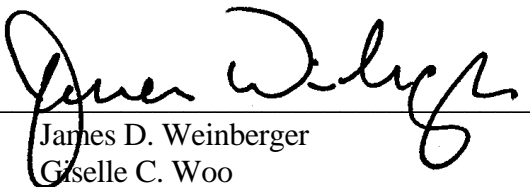
10. Applicant's use and registration of Applicant's Mark in connection with the goods identified in its application is likely to cause confusion, cause mistake or to deceive consumers into the false belief that Applicant's goods offered under Applicant's Mark come from or are otherwise authorized, sponsored by, or affiliated with Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

11. By reason of the foregoing, Opposer is likely to be harmed by registration of Application Ser. No. 77/783,198 for Applicant's Mark.

WHEREFORE, it is respectfully requested that this opposition be sustained and that the registration sought by Application Serial No. 77/783,198 be denied.

Dated: April 7, 2010  
New York, New York

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

By:   
James D. Weinberger  
Giselle C. Woo

866 United Nations Plaza  
New York, New York 10017  
(212) 813-5900

*Attorneys for Opposer*

# EXHIBIT A



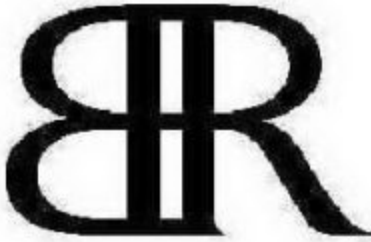
Thank you for your request. Here are the latest results from the [TARR web server](#).

This page was generated by the TARR system on 2010-04-07 12:13:52 ET

Serial Number: 78519571 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 3248232

Mark



(words only): [BR](#)

Standard Character claim: [No](#)

Current Status: [Registered](#).

Date of Status: [2007-05-29](#)

Filing Date: [2004-11-18](#)

Transformed into a National Application: [No](#)

Registration Date: [2007-05-29](#)

Register: [Principal](#)

Law Office Assigned: [LAW OFFICE 104](#)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)

Current Location: [650 -Publication And Issue Section](#)

Date In Location: [2007-04-26](#)

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**LAST APPLICANT(S)/OWNER(S) OF RECORD**

---

1. [Banana Republic \(Apparel\), LLC](#)

Address:

[Banana Republic \(Apparel\), LLC](#)

2 Folsom Street  
San Francisco, CA 94105  
United States

**Legal Entity Type:** [Limited Liability Company](#)  
**State or Country Where Organized:** [California](#)  
**Phone Number:** [415-427-5575](#)  
**Fax Number:** [415-427-2166](#)

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### GOODS AND/OR SERVICES

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**International Class:** [025](#)

**Class Status:** [Active](#)

[Clothing, namely, t-shirts, shirts, blouses, sweaters, vests, pants, jeans, shorts, dresses, skirts, jackets, blazers, suits, coats, sleepwear, swimwear, loungewear, jogging suits, sweatshirts, socks, underwear, lingerie, athletic pants, tops, belts, scarves, ties, gloves; footwear; headwear](#)

**Basis:** [1\(a\)](#)

**First Use Date:** [2005-08-18](#)

**First Use in Commerce Date:** [2005-08-18](#)

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### ADDITIONAL INFORMATION

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(NOT AVAILABLE)

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### MADRID PROTOCOL INFORMATION

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(NOT AVAILABLE)

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### PROSECUTION HISTORY

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**NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.**

[2007-05-29 - Registered - Principal Register](#)

[2007-04-09 - Law Office Registration Review Completed](#)

[2007-04-09 - Assigned To LIE](#)

[2007-03-17 - Allowed for Registration - Principal Register \(SOU accepted\)](#)

[2006-12-13 - Statement of use processing complete](#)

[2006-10-27 - Amendment to Use filed](#)

[2006-10-27 - TEAS Statement of Use Received](#)

[2006-03-30 - Extension 1 granted](#)

2006-03-30 - Extension 1 filed

2006-03-30 - TEAS Extension Received

2005-11-29 - Noa Mailed - SOU Required From Applicant

2005-09-06 - Published for opposition

2005-08-17 - Notice of publication

2005-04-29 - Law Office Publication Review Completed

2005-04-22 - Assigned To LIE

2005-04-16 - Approved for Pub - Principal Register (Initial exam)

2005-04-16 - Assigned To Examiner

2004-11-29 - New Application Entered In Tram

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**ATTORNEY/CORRESPONDENT INFORMATION**

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**Attorney of Record**

Julie Gruber

**Correspondent**

JULIE GRUBER

GPS SERVICES, INC.

2 FOLSOM ST

SAN FRANCISCO, CA 94105-1205

Phone Number: 415-427-5575

Fax Number: 415-427-2166

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This page was generated by the TARR system on 2010-04-07 12:15:06 ET

Serial Number: 78890744 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 3524256

Mark



(words only): [BR](#)

Standard Character claim: [No](#)

Current Status: [Registered](#).

Date of Status: [2008-10-28](#)

Filing Date: [2006-05-23](#)

Transformed into a National Application: [No](#)

Registration Date: [2008-10-28](#)

Register: [Principal](#)

Law Office Assigned: [LAW OFFICE 103](#)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)

Current Location: [650 -Publication And Issue Section](#)

Date In Location: [2008-10-28](#)

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**LAST APPLICANT(S)/OWNER(S) OF RECORD**

---

1. [BANANA REPUBLIC \(APPAREL\), LLC](#)

Address:

[BANANA REPUBLIC \(APPAREL\), LLC](#)

2 FOLSOM STREET  
SAN FRANCISCO, CA 94105  
United States

**Legal Entity Type:** [Limited Liability Company](#)  
**State or Country Where Organized:** [California](#)

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### GOODS AND/OR SERVICES

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**International Class:** [018](#)

**Class Status:** [Active](#)

[Leather, cloth and vinyl goods, namely, purses and handbags, wallets, briefcase-type portfolios, and briefcases](#)

**Basis:** [1\(a\)](#)

**First Use Date:** [1986-06-30](#)

**First Use in Commerce Date:** [1986-06-30](#)

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### ADDITIONAL INFORMATION

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**Color(s) Claimed:** [Color is not claimed as a feature of the mark.](#)

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### MADRID PROTOCOL INFORMATION

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(NOT AVAILABLE)

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### PROSECUTION HISTORY

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**NOTE:** To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

[2008-10-28 - Registered - Principal Register](#)

[2008-08-12 - Published for opposition](#)

[2008-07-23 - Notice of publication](#)

[2008-07-09 - Law Office Publication Review Completed](#)

[2008-07-08 - Approved for Pub - Principal Register \(Initial exam\)](#)

[2008-06-25 - TEAS Change Of Correspondence Received](#)

[2008-05-20 - LIE Checked Susp - To Atty For Action](#)

[2008-05-20 - LIE Checked Susp - To Atty For Action](#)

[2008-05-20 - LIE Checked Susp - To Atty For Action](#)

2008-05-20 - Assigned To LIE

2008-05-20 - Assigned To LIE

2008-01-02 - Automatic Update Of Assignment Of Ownership

2007-11-20 - Letter of suspension mailed

2007-11-19 - Suspension Letter Written

2007-11-02 - Teas/Email Correspondence Entered

2007-11-01 - Communication received from applicant

2007-11-01 - TEAS Request For Reconsideration Received

2007-06-01 - Final refusal mailed

2007-05-31 - Final Refusal Written

2007-05-17 - Teas/Email Correspondence Entered

2007-05-17 - Communication received from applicant

2007-05-17 - Assigned To LIE

2007-04-26 - TEAS Response to Office Action Received

2006-10-27 - Non-final action mailed

2006-10-27 - Non-Final Action Written

2006-10-24 - Assigned To Examiner

2006-05-31 - New Application Entered In Tram

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**ATTORNEY/CORRESPONDENT INFORMATION**

---

**Attorney of Record**

Paul D Supnik

**Correspondent**

PAUL D SUPNIK

9401 WILSHIRE BOULEVARD

SUITE 1012

BEVERLY HILLS, CA 90212

Phone Number: 310-859-0100

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Serial Number: 78519550 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 3096787

Mark



(words only): [BR](#)

Standard Character claim: [No](#)

Current Status: [Registered](#).

Date of Status: [2008-02-16](#)

Filing Date: [2004-11-18](#)

Transformed into a National Application: [No](#)

Registration Date: [2006-05-23](#)

Register: [Principal](#)

Law Office Assigned: [LAW OFFICE 104](#)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)

Current Location: [650 -Publication And Issue Section](#)

Date In Location: [2006-04-12](#)

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**LAST APPLICANT(S)/OWNER(S) OF RECORD**

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Address:

[Banana Republic \(Apparel\), LLC](#)

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San Francisco, CA 94105  
United States

**Legal Entity Type:** [Limited Liability Company](#)  
**State or Country Where Organized:** [California](#)  
**Phone Number:** [415-427-5575](#)  
**Fax Number:** [415-427-2166](#)

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### GOODS AND/OR SERVICES

---

**International Class:** [018](#)

**Class Status:** [Active](#)

[Handbags, wallets, purses, tote bags, duffel bags, briefcases, cosmetic bags sold empty, shaving bags sold empty, credit card cases, leather key cases; luggage](#)

**Basis:** [1\(a\)](#)

**First Use Date:** [2005-12-26](#)

**First Use in Commerce Date:** [2005-12-26](#)

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### ADDITIONAL INFORMATION

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(NOT AVAILABLE)

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### MADRID PROTOCOL INFORMATION

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(NOT AVAILABLE)

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### PROSECUTION HISTORY

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**NOTE:** To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

[2008-02-16 - Cancellation terminated for Proceeding](#)

[2008-02-16 - Cancellation dismissed for Proceeding](#)

[2007-10-30 - Cancellation Instituted No. 999999](#)

[2006-05-23 - Registered - Principal Register](#)

[2006-04-07 - Law Office Registration Review Completed](#)

[2006-04-07 - Assigned To LIE](#)

[2006-04-04 - Allowed for Registration - Principal Register \(SOU accepted\)](#)

[2006-03-16 - Statement of use processing complete](#)



2006-02-28 - Amendment to Use filed

2006-02-28 - TEAS Statement of Use Received

2005-11-29 - Noa Mailed - SOU Required From Applicant

2005-09-06 - Published for opposition

2005-08-17 - Notice of publication

2005-05-02 - Assigned To LIE

2005-05-02 - Law Office Publication Review Completed

2005-04-29 - Assigned To LIE

2005-04-18 - Approved for Pub - Principal Register (Initial exam)

2005-04-16 - Assigned To Examiner

2004-11-29 - New Application Entered In Tram

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**ATTORNEY/CORRESPONDENT INFORMATION**

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**Attorney of Record**

Julie Gruber

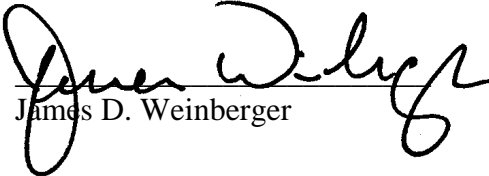
**Correspondent**

Linda K. McLeod  
Finnegan Henderson Farabow Garrett & Dun  
901 New York Avenue, NW  
Washington, DC 20001-4413  
Phone Number: 415-427-5575  
Fax Number: 415-427-2166

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**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing **NOTICE OF OPPOSITION** was sent by first class mail postage pre-paid to Applicant at its address of record, Andari Fashion Inc., 9626 Telstar Ave., El Monte, CA 91731, this 7th day of April, 2010.

  
James D. Weinberger